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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,599	01/10/2001	John G. Goddard	4147-10-PUS	1790

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EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 01/23/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/646,599**

Applicant(s)  
**Goddard**

Examiner  
**David Lukton**

Art Unit  
**1653**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 5, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above, claim(s) 1-4, 6, and 8-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Applicants' election of Group 13 is acknowledged. The previous species election (oleyl thiophosphoryl-2-O-methyl glycerate) remains in force.

Claims 1-4, 6 and 8-57 remain withdrawn from consideration. Claims 5 and 7 are examined in this Office action.

✱

**An abstract is required**, and does not appear to have been submitted.

✱

Claims 5 and 7 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Each of claims 5 and 7 is drawn to a composition. A composition, however, must contain at least two separate components. Thus, the claims effectively mandate the presence of a second component, yet provide no indication as to what that second component might be. The claims are thus rendered indefinite.
- Clarity would be improved if the definition of each of variables "Y", "R", "V", "Z", "L" and "X" began on a new line, i.e., the following format:

*Y is -O- or -S- ;*

*R is alkyl or alkenyl, wherein said alkyl or alkenyl is optionally substituted,  
or  $T-(CH_2)_p((CH_2)_pO)_q^-$ , wherein T is.... ;*

*V is OH, SH, H, NH<sub>2</sub> ...*

*Z is OH, SH, NH<sub>2</sub> ...*

*L is -O-, -S- or -CH<sub>2</sub>- ;*

*X is -O- or -S- ; ....*

- In claim 5, line 3, the following is recited: "OPO<sub>2</sub>HOPO<sub>3</sub>H<sub>2</sub>". It appears that this should be two words, rather than one.
- In claim 7, it appears that there is no reason to capitalize "Oleyl". Also, there should be a hyphen between the "3" and the "oleyl".

\*

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for the patent.

Claim 5 is rejected under 35 U.S.C. §102(b) as being anticipated by Earle (*J Org Chem* **61**, 5697, 1996).

Earle discloses compound 8 in scheme 2 (page 5698). This compound falls within the scope of instant claim 5 as follows (the designation "W1" and "W2" is intended to differentiate the two occurrences of "W" in the formula):

W1 = OH  
W2 = Q  
M = P  
X = O  
Z = OPO<sub>3</sub>H<sub>2</sub>  
Y = O

Also disclosed (page 5700) is that compound 8 was dissolved in water. A solution of this compound in water meets the requirement of claim 5 for a composition.

Thus, the claim is anticipated.

\*

The following is a quotation of 35 USC §103 which forms the basis for all obviousness rejections set forth in the Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

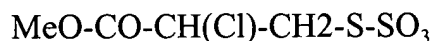
Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, absent evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each

claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Claim 5 is rejected under 35 U.S.C. §103 as being unpatentable over JP 58-10559.

JP 58-10559 discloses (table, page 481, col 1) the following compound:



This corresponds to the claimed compounds as follows:

M = S

Y = S

Z = Cl

X = O

R = methyl

The assumption at this point in time is that the reference does not disclose a composition of this compound. However, one of ordinary skill would have expected at least trace amounts of impurities to accompany the formation of this compound during synthesis, or at least that if solvent is used, then the compound dissolved in the solvent would qualify. If impurities are present at the level of just one part-per-billion, then the result is a composition.

Thus, the claim is rendered obvious.

\*

Claim 5 is rejected under 35 U.S.C. §103 as being unpatentable over Saksena (USP 5,693,626).

Saksena discloses compound 52 at cols 37-38. Also disclosed (col 52, line 23+) is that the compound 52 was obtained by undertaking a reaction (of the precursor) in a solvent. Compound 52 falls within the scope of the claimed genus because claim 5 permits substituent variable "R" to be a **substituted** alkyl.

Thus, it would have been obvious to one of ordinary skill that the compound of claim 52 would be present in a composition containing solvent and other impurities.

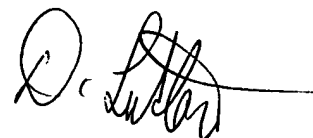
\*

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



DAVID LUKTON  
PATENT EXAMINER  
GROUP 1800